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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/711,823	10/07/2004	Burkhard Pollak	LUKP:123US	5822
24041	7590	08/29/2006	EXAMINER	
SIMPSON & SIMPSON, PLLC 5555 MAIN STREET WILLIAMSVILLE, NY 14221-5406			PILKINGTON, JAMES	
			ART UNIT	PAPER NUMBER
			3682	

DATE MAILED: 08/29/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/711,823	Applicant(s) POLLAK ET AL.	
	Examiner James Pilkington	Art Unit 3682	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 August 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 and 3-9 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1 and 3-9 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☒ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Continued Prosecution Application

The request filed on August 14, 2006 for continued examination (RCE) is acceptable and an action on the RCE follows.

Priority

Acknowledgment is made of applicant's claim for foreign priority based on an application filed in Germany/PCT. It is noted, however, that applicant has not filed a certified copy of the priority applications as required by 35 U.S.C. 119(b).

Specification

The disclosure is objected to because of the following informalities: paragraph 12 line 4 reads "selector switch 2" should be - - selector shaft 2 - -.

Appropriate correction is required.

Claim Objections

Claim 3 is objected to because of the following informalities: line 4 of the claim reads "...into a gearbox actuator housing" should be - - into the gearbox housing - - since the Figures show the protruding rods attached to the bottom of the gearbox actuator housing and going through a recess into the gearbox housing.

Appropriate correction is required.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1 and 3-9 are rejected under 35 U.S.C. 112, first paragraph, as based on a disclosure which is not enabling. How the shift finger and disengaging elements *operate the gearshift rails* (clm 1 line 3) is critical or essential to the practice of the invention which is not disclosed in either the specification, the claims or the drawings. How do the shift finger and disengaging members operate the gearshift rails? How does the shift finger shift? How do the disengaging members disengage? What do the shift finger and disengaging member communicate with on the shift rails to move them?

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 1 and 3-9 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 recites the limitation "a single selector shaft driven by a drive and arranged in a housing upon which are arranged a shift finger and disengaging elements." It is unclear as to what the finger and disengaging element are arranged on, is it the selector shaft, the drive or the housing?

Claims 5 and 7 recite the limitations "...opposite each other with respect to the selector shaft" (clm 5) and "...symmetrically opposite..." (clm 7). It is unclear as to how the rods are opposite each other since the selector shaft has multiple axis of symmetry and both a horizontal axis and a vertical axis for the rods to be opposite about.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1 and 3-9 are rejected under 35 U.S.C. 102(b) as being anticipated by Jerwick, USP 6,082,215.

Re clm 1, Jerwick discloses a gearbox actuator comprising:

- A single selector shaft (34) driven by a drive (36) and arranged in a housing (64/50) upon which are arranged a shift finger (shaft between rotating ball joint 70 and the disengaging elements) and disengaging elements (curved surfaces on the left and right of the shift finger) that operate gearshift rails (96 and the rail that runs between protrusions 86 and 88)
- A bearing arrangement (protrusions 80, 82, 86 and 88) operatively arranged to support the gearshift rails
- Wherein said bearing arrangement is formed by protruding rods (they protrude out from the base of the housing member 50)

Re clm 3, the housing comprises an attachment part (base 50) operatively arranged to be attached to a gear housing of a gearbox (screwed on, see Figures 2 and 5) where in the protruding rods protrude through an opening or recess in the gear housing into the gearbox actuator housing (see Figures 5, 6A and 6B).

Re clm 5, there are provided two upper protruding rods (80 and 88) and two lower two lower protruding rods (82 and 86) that are opposite each other with respect to the selector shaft.

Re clm 6, two protruding rods are provided (80 and 82).

Re clm 7, where in each member of an upper pair of protruding rods (80 and 88) and each member of a lower pair of protruding rods (82 and 86) that are symmetrically opposite each other with respect to the selector shaft.

Re clm 8, the protruding rods have guide shoe parts (holes 90, 92, and 210) at their ends resting against the gearshift rails.

Clms 4 and 9 are product-by-process claims and product-by-process claims are not limited to the manipulations of the recited steps, only the structure implied by the steps.

Response to Arguments

Applicant's arguments with respect to claim 1 and 3-9 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to James Pilkington whose telephone number is (571) 272-5052. The examiner can normally be reached on Monday-Friday 8:00AM-4:00PM.

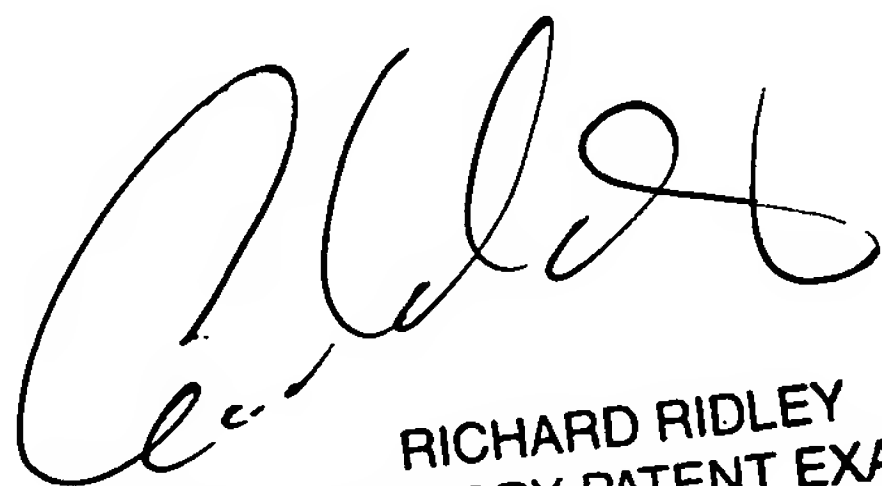
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Richard Ridley can be reached on (571) 272-6917. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 3682

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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8.24.06

A handwritten signature in black ink, appearing to read 'Richard Ridley', is written over a circular stamp.

RICHARD RIDLEY
SUPERVISORY PATENT EXAMINER